

REMARKS

Status Of Application

Claims 52-67 are pending in the application; the status of the claims is as follows:

Claim 53 is objected to because of informalities.

Claim 64 is rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,034,804 to Sasaki et al ("Sasaki").

Claims 52-67 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,067,029 to Takahashi ("Takahashi") in view of Sasaki.

Claims 52-67 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of U.S. Patent No. 4,887,161 to Watanabe et al. ("Watanabe").

Claim Amendments

Claims 52-55 have been amended to more particularly point out and distinctly claim inventive subject matter. Claim 66 has been amended to correct the dependency thereof. These changes do not introduce any new matter.

35 U.S.C. § 102(e) Rejection

For a reference to anticipate a claim, the reference must disclose each and every element as set forth in the claim, in as complete detail as is contained in the claim, and arranged as required by the claim. MPEP 2131. The rejection of claim 64 under 35 U.S.C. § 102(e) as being anticipated by Sasaki, is respectfully traversed, because Sasaki fails to disclose each and every element as set forth in the claim, in as complete detail as is contained in the claim, and arranged as required by the claim.

Claim 64 requires, *inter alia*,

“a controller adapted to:

...
accept a user input to capture a first image;
capture the first image from said imaging device responsive to
the user input;
store the first image in a memory card if the memory card has
sufficient remaining capacity;
determine a remaining capacity of a memory card after the first
image is stored to the memory card and prior to accepting a user input to
capture a second image;
....”

The controller performs several operations in a specified order. First, the controller accepts an input from the user to capture an image. Second, an image is captured. Third, the image is stored to the memory card. Fourth, the remaining capacity of the memory card is determined. And fifth, a user input is accepted to capture a second image.

It is respectfully submitted that Sasaki does not disclose the claimed sequence of operations. The only sequence disclosed by Sasaki is provided in the flowchart of Fig. 10 and the corresponding description at column 9, lines 1-35. As shown and described, a user input is accepted in step ST 1, the capacity of the memory is determined at step ST 5, and the image data is recorded to the memory card as step ST 7. That is, Sasaki discloses that the memory capacity is determined (ST5) *after* the user presses the shutter release (ST1) and *before* the image is stored to the memory card (ST7). Whereas, claim 64 clearly requires that the memory capacity is determined *after* the user presses the shutter release a first time and *after* the image is stored to the memory card, but *before* the user presses the shutter release a second time.

Of particular note, Sasaki shows in Fig. 10 that after the image data is recorded (ST7) the recording procedure ends. The only way to return to the step of determining the memory capacity of the memory card (ST5) is to first accept a user input to capture an image (ST1). Thus, Sasaki only discloses the sequence ST1 \Rightarrow ST5 \Rightarrow ST7 \Rightarrow ST1 \Rightarrow ..., claim 64 requires a sequence corresponding to ST7 \Rightarrow ST5 \Rightarrow ST1 \Rightarrow ST7 \Rightarrow Clearly, Sasaki discloses the opposite of the sequence required by claim 64.

Accordingly, it is respectfully requested that the rejection of claim 64 under 35 U.S.C. § 102(e) as being anticipated by Sasaki, be reconsidered and withdrawn.

35 U.S.C. § 103(a) Rejections

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP 2143.

The rejection of claims 52-67 under 35 U.S.C. § 103(a), as being unpatentable over Takahashi in view of Sasaki, is respectfully traversed because the combination fails to teach all the limitations of the rejected claims.

Claim 52 has been amended to recite, *inter alia*, “a controller which (a) controls said detector to detect a capacity of the inserted memory card after the recorder stores image information in the memory card and prior to said imaging device conducting a next photographing operation.” That is, the controller checks the capacity of the memory card after an image is saved, but before the user presses the shutter release to capture the next image. By checking the remaining capacity just after writing an image, the user can be warned that the memory card is full before the user presses the shutter release to take another picture. Takahashi does not teach anything with regard to when a capacity of a removable storage unit is checked. Sasaki only teaches that the capacity of the memory card is checked just after the user presses the shutter release and prior to recording the information to the memory card. See Sasaki, Fig. 10 and Column 9, lines 4-35. A camera based on the combined teachings of Takahashi and Sasaki can only warn the user that the memory card is full after the user presses the shutter release, but there is no room to store the just taken picture on the memory card. Because the combination of Takahashi and Sasaki fails to teach

all elements of claim 52, it is respectfully submitted, that the combination is distinguished by amended claim 52, as well as by claims 56, 60, 66, and 67 which depend therefrom.

Claim 53 has been amended to recite, *inter alia*, “a controller which ... controls said detector to detect an available capacity of a memory card at the time the memory card is inserted into the card slot and just after said recorder stores image information in the memory card.” That is, the capacity of the memory card is checked *just after* an image is recorded on the memory card. As discussed above in regards to claim 52, Takahashi does not teach anything about when the capacity of a memory device is checked; and Sasaki only teaches checking the capacity of the memory card *just prior* to recording an image on the memory card. It is respectfully submitted, therefore, that the combination of Takahashi and Sasaki is distinguished by amended claim 53, as well as by claims 57 and 61 which depend therefrom.

Claim 54 has been amended to recite, *inter alia*, “displays a warning just after storing image information to the memory card if the remaining capacity detected by the detector is insufficient to store image information from a next photographing operation, even if a remaining capacity of the inside memory is sufficient.” That is, the capacity of the memory card is checked *just after* an image is recorded on the memory card. Takahashi does not teach anything about displaying a warning when a memory device does not have capacity to store another image. Sasaki only teaches checking the capacity of the memory card *just prior* to recording an image on the memory card and providing a warning if the image can not be stored. See Fig. 10. Neither reference discloses, teaches, or otherwise suggests providing a warning just after an image is written to the memory card. It is respectfully submitted, therefore, that the combination of Takahashi and Sasaki is distinguished by amended claim 54, as well as by claims 58 and 62 which depend therefrom.

Claim 55 has been amended to recite, *inter alia*, “a controller which controls said changer so that ... (c) a warning is displayed immediately after recording image information to the memory card when the memory card is inserted in the card slot to store the image information therein and the remaining capacity detected by the detector is insufficient to store

subsequent image information even if a remaining capacity of the inside memory is sufficient.” That is, a warning may be displayed *just after* an image is recorded on the memory card if there is no room for another image. Takahashi does not teach anything about displaying a warning when a memory device does not have capacity to store another image. Sasaki only teaches checking the capacity of the memory card *just prior* to recording an image on the memory card and providing a warning if the image can not be stored. See Fig. 10. Neither reference discloses, teaches, or otherwise suggests providing a warning just after an image is written to the memory card. It is respectfully submitted, therefore, that the combination of Takahashi and Sasaki is distinguished by amended claim 55, as well as by claims 59 and 63 which depend therefrom.

Claim 64 requires, *inter alia*, “a controller adapted to ... determine a remaining capacity of a memory card after the first image is stored to the memory card and prior to accepting a user input to capture a second image...” As discussed above regarding claims 52, 53, 54, and 55, this feature of claim 64 is not taught by Takahashi or Sasaki. It is respectfully submitted, therefore, that the combination of Takahashi and Sasaki is distinguished by claim 64, as well as by claim 65 which depends therefrom.

Accordingly, it is respectfully requested that the rejection of claims 52-67 under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of Sasaki, be reconsidered and withdrawn.

The rejection of claims 52-67 under 35 U.S.C. § 103(a), as being unpatentable over Takahashi in view of Watanabe, is respectfully traversed, because the combination fails to teach all the limitations of the rejected claims.

Amended claim 52 requires, *inter alia*, “a controller which (a) controls said detector to detect a capacity of the inserted memory card after the recorder stores image information in the memory card but prior to said imaging device conducting a next photographing operation.” As stated above, Takahashi does not teach anything with regard to when a capacity of a removable storage unit is checked. Watanabe only teaches that when a memory

card is inserted into the camera, the memory card is searched to determine the number of remaining frames. The number of remaining frames is loaded into a counter, and the counter is decremented whenever an image is saved to the memory. Thus, Watanabe does not teach that the controller controls the detector to detect the capacity of the card as required by claim 52. Rather, Watanabe merely references the counter to determine capacity. Because the combination of Takahashi and Watanabe fails to teach all elements of claim 52, it is respectfully submitted, that the combination is distinguished by amended claim 52, as well as by claims 56, 60, 66, and 67 which depend therefrom.

Claim 53 has been amended to recite, *inter alia*, “a controller which ... controls said detector to detect an available capacity of a memory card at the time the memory card is inserted into the card slot and just after said recorder stores image information in the memory card.” That is, the capacity of the memory card is detected *just after* an image is recorded on the memory card. As discussed above in regards to claim 52, Takahashi does not teach anything about when the capacity of a memory device is checked, and Watanabe only teaches detecting the capacity of the memory card when the memory card is first loaded into the camera. It is respectfully submitted, therefore, that the combination of Takahashi and Watanabe is distinguished by amended claim 53, as well as by claims 57 and 61 which depend therefrom.

Claim 54 has been amended to recite, *inter alia*, “displays a warning just after storing image information to the memory card if the remaining capacity detected by the detector is insufficient to store image information from a next photographing operation, even if a remaining capacity of the inside memory is sufficient.” That is, the capacity of the memory card is checked *just after* an image is recorded on the memory card. Takahashi does not teach anything about displaying a warning when a memory device does not have capacity to store another image. Sasaki only teaches checking the capacity of the memory card *just prior* to recording an image on the memory card and providing a warning if the image can not be stored. See Fig. 10. Neither reference discloses, teaches, or otherwise suggests providing a warning just after an image is written to the memory card. It is respectfully submitted,

therefore, that the combination of Takahashi and Sasaki is distinguished by amended claim 54, as well as by claims 58 and 62 which depend therefrom.

Claim 55 has been amended to recite, *inter alia*, “a controller which controls said changer so that ... (c) a warning is displayed immediately after recording image information to the memory card when the memory card is inserted in the card slot to store the image information therein and the remaining capacity detected by the detector is insufficient to store subsequent image information even if a remaining capacity of the inside memory is sufficient.” As discussed above, Takahashi does not teach anything about displaying a warning when a memory device does not have capacity to store another image. Watanabe only teaches displaying the remaining number of frames on the memory card. See Fig. Column 5, lines 28-30. It is respectfully submitted, however, that merely indicating the number of remaining frames is not the same as displaying a warning. For example, the ‘3’ indicated by reference D1 in Fig. 1, could easily be overlooked or misunderstood as an exposure parameter or a frame number. It is respectfully submitted, therefore, that the combination of Takahashi and Watanabe is distinguished by amended claim 55, as well as by claims 59 and 63 which depend therefrom.

Claim 64 requires, *inter alia*, “a controller adapted to ... determine a remaining capacity of a memory card after the first image is stored to the memory card and prior to accepting a user input to capture a second image...” As discussed above regarding claims 52, 53, 54, and 55, this feature of claim 64 is not taught by Takahashi or Watanabe. It is respectfully submitted, therefore, that the combination of Takahashi and Watanabe is distinguished by claim 64, as well as by claim 65 which depends therefrom.

Accordingly, it is respectfully requested that the rejection of claims 52-67 under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of Watanabe, be reconsidered and withdrawn.

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin LLP Deposit Account No. 18-1260.

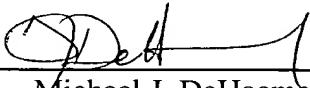
If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee,

Application No. 08/468,437
Amendment dated December 7, 2006
Reply to Office Action of August 8, 2006

and not submitted herewith should be charged to Sidley Austin LLP Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

By: 

Michael J. DeHaemer
Registration No. 39,164
Attorney for Applicants

MAD/llb:jjk:bar
SIDLEY AUSTIN LLP
717 N. Harwood, Suite 3400
Dallas, Texas 75201
Direct: (214) 981-3335
Main: (214) 981-3300
Facsimile: (214) 981-3400
December 7, 2006